

## **REMARKS/ARGUMENTS**

In response to the requirement in the Interview Summary mailed in the above-captioned application on July 28, 2008 that the formal written reply to the last Office Action must include the substance of the interview conducted on July 23, 2008 between Applicants' representative and the Examiner, the substance of that interview follows.

Applicants' representative discussed with the Examiner whether the feature of the atoms being separated by a distance of less than 10 nm is supported in the specification. The Examiner was uncertain whether that feature was supported, and will decide the matter in the next office action.

With regard to the term "complicated" in claims 1, 13 and 14, the Examiner agreed that deleting the word "complicated" from the claims would overcome the present rejection of claims 1, 13 and 14 under 35 U.S.C. § 112, second paragraph.

With regard to the rejection of claim 1 under 35 U.S.C. § 103(a), the Examiner attempted to point to column 4, the paragraph beginning at line 29 and the paragraph beginning at line 37, in Sakurai et al., U.S. Patent No. 6,869,683, as disclosing the remainder of the group of binding agent materials other than polyurethane resin claimed in claim 1, which the Examiner admitted was not disclosed by Senda et al., U.S. Patent No. 5,990,417, (see Office Action, pages 4-5). The Examiner did not decide during the interview whether the exclusion of the polyurethane resin from claim 1 would render it allowable.

The rejection of claims 1, 13 and 14 under 35 U.S.C. § 103(a) and the argument which was presented in the Amendment filed in the above-captioned application and dated April 7, 2008, (hereinafter referred to as "the Amendment dated April 7, 2008"), that Senda et al. does not show that the imaginary part of the complex magnetic permeability at 8 GHz is higher than the imaginary part of the complex magnetic permeability at 5 GHz, was also discussed during the interview. The Examiner indicated that, despite the arguments advanced by Applicants' representative during the interview, based on Figs. 12, 13, 37 and 38 of Senda et al., that the relative magnetic permeability appears to decrease with an increase in frequency, he was not convinced that Senda et al. was overcome. Furthermore, his position would be the same even if claims 1, 13, and 14 were amended to state that the imaginary part of the complex magnetic permeability increases steadily with the frequency.

In either case, the Examiner indicated that he has no way to compare the reference with the above-captioned application other than relying on the similar materials in Senda et al. and the above-captioned application and therefore the inherent similarity of the physical properties of those materials as set forth in the Office Action. The Examiner indicated that he would require a declaration stating that the material disclosed in Senda et al. has an imaginary part of complex magnetic permeability which decreases with frequency in order for the claims in the above-captioned application to distinguish over that reference.

However, during the interview, in discussing a way to advance prosecution of the above-captioned application, Applicants' representative referred to a portion of the specification which may be used to introduce features into the claims that the Examiner indicated may distinguish over the cited references.

In particular, page 16, lines 19-25, of the specification was referred to, indicating that the thickness of the composite layer is roughly in the range of 1.5 to 3 times thickness of the magnetic material formed by the vapor deposition. Furthermore, page 16, line 25, to page 17, line 13, of the specification was referred to, indicating a preferred thickness of the magnetic layer being not less than 0.005  $\mu\text{m}$ , and further indicating that the thickness of the composite layer is preferably 1  $\mu\text{m}$  or less, more preferably 0.3  $\mu\text{m}$  or less.

Claim 14 was rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Reconsideration of the rejection is respectfully requested.

The Examiner alleges, in support of the rejection, that atoms of the magnetic material being separated by a distance of less than 10 nm are not disclosed in the specification.

As stated previously in the Amendment dated April 7, 2008, antecedent basis for the feature of claim 14 that atoms of the magnetic material are separated by less than 10 nm is found, for example, on page 15, line 23, to page 16, line 12, of the specification, and in the drawings, for example, in Figs. 1 and 2. Fig. 1 "shows an image of a composite layer of an electromagnetic noise suppressor of the present invention observed with a high-resolution transmission electron microscope," (specification, page 13, lines 2-5), Fig. 1 being marked with a scale of 10 nm alongside the drawing.

In addition to the arguments found in the Amendment dated April 7, 2008 supporting the allegation that the previously referred feature of claim 14 is supported by the specification and drawings, it should be noted that it is stated in the portion of the specification referred to that,

“[m]ore specifically, as shown in the high-resolution transmission electron microscope image of Fig. 1 and the sketch of Fig. 2 which simplifies the electron microscope image, the electromagnetic noise suppressor 1 is constituted only from the composite layer 3 consisting of atoms of the magnetic material mixed with molecules of the binding agent 2, and a layer consisting only of the binding agent 2,” (specification, page 15, line 23, to page 16, line 4). Furthermore, the specification states that, “[t]he composite layer 3 consists of ... a portion where atoms of the magnetic material 5 are observed to be dispersed in the binding agent without crystallizing,” (specification, page 16, lines 5, 10-12). An examination of the atoms of the magnetic material 5 in Fig. 2, which is indicated by the specification to be a simplification of the electron microscope image of Fig. 1, which shows a scale of 10 nm, appears to show that atoms of magnetic material 5 are separated by less than 10 nm, as provided in independent claim 14. Therefore, the rejection of the Examiner should be withdrawn.

Claims 1, 13, and 14 were rejected under 35 U.S.C. §112, second paragraph. Reconsideration of the rejection is respectfully requested.

The word “complicated” has been deleted from claims 1, 13, and 14, and, therefore, the rejection of claims 1, 13, and 14 under 35 U.S.C. §112, second paragraph, should be overcome, in accordance with the Examiner’s agreement in the telephonic interview of July 23, 2008 that deleting the word “complicated” from the claims would overcome the rejection of claims 1, 13, and 14 under 35 U.S.C. §112, second paragraph. The agreement of the Examiner is mentioned in the statement of the substance of the interview appearing above.

Claims 1, 3, 5-7, and 13-14 were rejected under 35 U.S.C. §103(a) as being unpatentable over Senda et al., U.S. Patent No. 5,990,417, in view of Sakurai et al., U.S. Patent No. 6,869,683. Reconsideration of the respectfully requested.

Since the Examiner has mentioned the use of polyurethane rubber in Sakurai et al., (Office Action, page 5, lines 2-5), and since in the interview conducted on July 23, 2008, the Examiner referred to column 4, the paragraphs beginning at lines 29 and 37 of Sakurai et al., which appear to disclose a form of polysiloxanes, (see statement of substance of interview above), Applicants have deleted polyurethane resin, polysiloxane resin, and urethane rubber from independent claim 1 in order to overcome this ground of rejection of independent claim 1.

Independent claims 1, 13, and 14 have been amended to provide for the thickness of the composite layer being at least 0.005  $\mu\text{m}$  and at most 0.3  $\mu\text{m}$ . Antecedent basis for this

amendment to independent claims 1, 13, and 14 is found in the specification, as amended herein, for example, on page 16, line 25, to page 17, line 13. Regarding the amendment of the specification on page 16, line 25, to page 17, line 1, to change “magnetic material layer” to -- composite layer--, the amendment is necessary due to an error in the translation into English of Japanese language International Application No. PCT/JP2004/002104 as filed, which English translation was filed herein as the above-captioned application. A Declaration confirming the occurrence of this translation error is attached hereto. In addition, the fact that a translation error occurred can be inferred from an examination of the sentence from page 16, line 25, to page 17, line 6, of the specification as filed, which appears to erroneously reference “the magnetic material layer,” when read in context with the following sentence on page 17, lines 6-10, of the specification.

The feature claimed in claims 1, 13, and 14 of the thickness of the composite layer being at least 0.005  $\mu\text{m}$  and at most 0.3  $\mu\text{m}$  does not appear to be disclosed, taught, or suggested by Senda et al. nor Sakurai et al.

In addition, as argued in the Amendment filed in the above-captioned application and dated February 5, 2008 and the Amendment dated April 7, 2008, Figs. 12 and 13 of Senda et al. appear to show that the relative magnetic permeability  $\mu_r''$ , which appears to correspond to an imaginary part  $\mu''_H$  or  $\mu''_L$  of the complex magnetic permeability of independent claims 1, 13, and 14, at 8 GHz is smaller than the relative magnetic permeability  $\mu_r''$  at 5 GHz, (see Amendment dated February 5, 2008, page 7, second full paragraph; Amendment dated April 7, 2008, page 7, fifth full paragraph, page 8, fourth full paragraph). Therefore, the provision of independent claims 1, 13, and 14 providing that an electromagnetic noise suppressor has an imaginary part  $\mu''_H$  of complex magnetic permeability at 8 GHz which is higher than an imaginary part  $\mu''_L$  of complex magnetic permeability at 5 GHz is different from the disclosure of Senda et al.

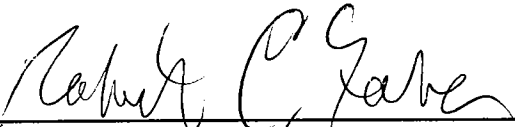
Since each of claims 3 and 5-7 is directly or indirectly dependent upon independent claim 1, each of claims 3 and 5-7 is allowable for at least the same reasons recited above with respect to the allowability of independent claim 1.

In view of the foregoing amendments and remarks, allowance of claims 1, 3, 5-7, 13, and 14 is respectfully requested.

Respectfully submitted,

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Robert C. Faber  
Registration No.: 24,322  
OSTROLENK, FABER, GERB & SOFFEN, LLP  
1180 Avenue of the Americas  
New York, New York 10036-8403  
Telephone: (212) 382-0700